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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/833,173	04/11/2001	Jeffrey Jonathan Spurgat	11748/16	1523
<div>7590      08/22/2007</div> <div>John S. Paniaguas KATTEN MUCHIN ZAVIS Suite 1600 525 West Monroe Street Chicago, IL 60661</div> <div>EXAMINER CHOUDHURY, AZIZUL Q</div> <div>ART UNIT      PAPER NUMBER 2145</div> <div>MAIL DATE      DELIVERY MODE 08/22/2007      PAPER</div>				

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

09/833,173

**Applicant(s)**

SPURGAT ET AL.

**Examiner**

Azizul Choudhury

**Art Unit**

2145

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Detailed Action***

This office action is in response to the correspondence received on July 12, 2007.

***Claim Objections***

Claim 4 is objected to because of the following informalities: The term "(New)" is present within the term peripheral. This appears to be a typographical error.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 8 and 9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claims feature "play lists." Support for a play list could not be found within the specifications.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al (US Pat No: 6,697,944) in view of Birrell et al (US Pat No: 6,332,175), hereafter referred to as Jones and Birrell, respectively.

1. With regards to claim 1, Jones teaches through Birrell a secure architecture for encoded or encrypted digital audio files comprising: a computing platform for receiving and storing encrypted or encoded digital data from the Internet as well as storing local encrypted or encoded data, and processing said encrypted or encoded digital data, said computing platform including a host processor and a peripheral bus, said computing platform configured to run audio or video playback application software for passing said encrypted or encoded digital data to said peripheral bus, said computing platform configured so that said peripheral bus is not-accessible by said audio or video playback software (Jones' design features a pc (Figure 1 and column 6, line 51 – column 7, line 4, Jones) and provides for trust establishments prior to allowing for the connection between the playback device and the pc from being established (column 4, lines 15-20, Jones) and also provides for unauthorized software not having access to the secure data (audio files, etc) (column 13, lines 26-40, Jones)); a playback device configured to be connected to said computing platform for receiving encrypted or encoded digital data from said computing platform, said playback device

including a separate processor, a peripheral bus interface (Figure 5 and column 9, lines 33-53, Jones), a timing generator and a digital-to-analog converter (DAC) for receiving said encrypted or encoded digital signals from said peripheral bus and decrypting or decoding said encrypting or encoded data signals, said timing generator configured to generate timing signals for said DAC (Timing generators are inherent components of digital designs such as Jones', column 10, lines 8-39 and column 14, lines 18-20, Jones), said playback device also including a memory device for storing decoding or decryption software (The playback device/peripheral has means for decrypting encrypted data (column 4, lines 8-12 and Figure 5, element 86, Jones)), said peripheral interface coupled to said peripheral bus for receiving said encrypted and encoded digital signals from said peripheral bus (Figure 5, element 68, Jones), said playback device configured to decrypt or decode said encrypted or encoded digital data and generate a decoded or decrypted analog output signal for playback by an external analog device, said playback device configured to download said encrypted or encoded digital data from the Internet for playback on said playback device (column 4, lines 8-12 and Figure 5, elements 82, 88, 92 and 94, Jones).

While Jones' design teaches the use of digital files for providing music (analog data), Jones does not specifically cite the use of a D/A converter.

In the same field of endeavor, Birrell teaches a portable audio system that connects to a host (column 4, lines 37-49, Birrell). The design features a D/A converter (Figure 1, element 126, Birrell). Therefore, it would have been obvious

to one skilled in the art, during the time of the invention, to have combined the teachings of Jones with those of Birrell, for the purpose of providing a system and method for storing a large volume of audio data in a portable audio player (column 2, lines 49-52, Birrell).

2. With regards to claim 2, Jones teaches through Birrell the secure architecture, wherein said computing platform includes a network interface for receiving digital data from an external network (column 7, lines 38-40, Jones).
3. With regards to claim 3, Jones teaches through Birrell the secure architecture, wherein said peripheral bus is a USB bus (column 9, lines 37-53, Jones).
4. With regards to claim 4, Jones teaches through Birrell the secure architecture, wherein said peripheral bus is a PCI bus (column 9, lines 37-53, Jones).
5. With regards to claim 5, Jones teaches through Birrell the secure architecture, wherein said peripheral bus is a Fire Wire bus (Jones' design allows for the use of buses, it would have been obvious to have used a FireWire bus; column 9, lines 37-53, Jones).

6. With regards to claim 6, Jones teaches through Birrell the secure architecture further including one or more user input devices (Figure 1, elements 40 and 42, Jones).
7. With regards to claim 7, Jones teaches through Birrell the secure architecture, wherein said computing architecture includes one or more local persistent storage devices (Figure 1, elements 29 and 60, Jones).
8. With regards to claim 8, Jones teaches through Birrell a secure architecture for encoded or encrypted digital audio files comprising: a computing platform for receiving and storing encrypted or encoded digital data from the Internet as well as storing local encrypted or encoded data, and processing said encrypted or encoded digital data, said computing platform including a host processor and a peripheral bus, said computing platform configured to run audio or video playback application software for passing said encrypted or encoded digital data to said peripheral bus, said computing platform configured so that said peripheral bus is not-accessible by said audio or video playback software (Jones' design features a pc (Figure 1 and column 6, line 51 – column 7, line 4, Jones) and provides for trust establishments prior to allowing for the connection between the playback device and the pc from being established (column 4, lines 15-20, Jones) and also provides for unauthorized software not having access to the secure data (audio files, etc) (column 13, lines 26-40, Jones)); a playback device

configured to be connected to said computing platform for receiving encrypted or encoded digital data from said computing platform, said playback device including a separate processor, a peripheral bus interface (Figure 5 and column 9, lines 33-53, Jones), a timing generator and a digital-to-analog converter (DAC) for receiving said encrypted or encoded digital signals from said peripheral bus and decrypting or decoding said encrypting or encoded data signals, said timing generator configured to generate timing signals for said DAC (Timing generators are inherent components of digital designs such as Jones', column 10, lines 8-39 and column 14, lines 18-20, Jones), said playback device also including a memory device for storing decoding or decryption software (The playback device/peripheral has means for decrypting encrypted data (column 4, lines 8-12 and Figure 5, element 86, Jones)), said peripheral interface coupled to said peripheral bus for receiving said encrypted and encoded digital signals from said peripheral bus (Figure 5, element 68, Jones), said playback device configured to decrypt or decode said encrypted or encoded digital data and generate a decoded or decrypted analog output signal for playback by an external analog device, wherein said playback is configured to enable creation of a playlist (column 4, lines 8-12 and Figure 5, elements 82, 88, 92 and 94, Jones; and see column 5, line 1, Birrell).



9. With regards to claim 9, Jones teaches through Birrell, the secure architecture, wherein said playback device is further configured to enable editing of said play list (see column 5, line 1, Birrell).
10. The obviousness to combine motivation applied to claim 1 are applicable to claims 2-9.

### ***Response to Remarks***

The amendment received on July 12, 2007 has been carefully examined but is not deemed fully persuasive. In lieu of the amendments, the 112-type rejection issued in the previous office action has been withdrawn. However, the amendments have created an enablement issue. Claims 8 and 9 feature a play list. Support for a play list could not be found within the specifications. Appropriate corrections are required.

The first point of contention involves the claim feature of downloading encrypted/encoded data from the Internet for playback on a playback device. Both Jones and Birrell teach the use of playback devices. At least the Jones art teaches playback can be performed on encrypted files. In addition, Jones also teaches the files being downloaded from the Internet. Furthermore, Birrell teaches the use of playlists as newly claimed (see column 5, line 1, Birrell).

The second point of contention involves the motivation to combine the prior arts. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is

some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, motivation to combine was found within the references.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Azizul Choudhury whose telephone number is (571) 272-3909. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on (571) 272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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**PATRICE WINDER**  
**PRIMARY EXAMINER**